REMARKS

Rejections under 35 USC § 103(a)

Claims 1, 3-5, 7-10, 12-13, 15 and 18-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,460,592 to Langton et al. ("Langton") in view of United States Patent No. 5,863,790 to Bolea ("Bolea"). Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,106,455 to Kan in view of the combination of Langton et al. and Bolea. These rejections are respectfully traversed and reconsideration is respectfully requested.

In the present invention, Applicants disclose in claim 1 that the radioactive seeds are subjected to dry heat at a temperature of at least 140°C for a minimum of 2 hours to effect sterilization.

In the Office Action dated August 17, 2006 ("Office Action"), the Examiner states "it would have been obvious to one of ordinary skill in the medical arts at the time the invention was made to use a time period of at least two hours for dry heat sterilization for the device of Langton as set forth in Bolea to ensure the device is properly sterilized." Applicants respectfully disagree. First, Bolea states in column 1, lines 39-42 that dry heat sterilization involves exposing the devices being sterilized to temperatures in a range of approximately 180°C or higher for at least two hours. Second, Langton teaches a time of one-hour to sterilize a seed train. Applicants agree with the Examiner's observation on page 2 of the

Office Action that Langton does not suggest, disclose or teach a time of two hours for sterilization. Therefore, one skilled in the art would be discouraged from increasing the one-hour time for sterilization in Langton because the seed train is sterilized and stiffened in one hour. Additionally, it would not be practical if one skilled in the art were to continue to apply dry heat at 180°C and higher as disclosed in Bolea to the seed train in Langton if the seed train in Langton was already sterilized in one hour. Accordingly, one skilled in the art would not seek to improve Langton by continuing to prolong the time when sterilization of the seed train has already occurred, i.e. 1-hour to 2-hours.

Hence, the temperature and time requirements of independent claim 1 in the present invention would not have been obvious to one skilled in the art in view of Langton to Bolea.

It is well settled in case law that prior patents such as Langton and Bolea are references only for what they clearly disclose or suggest. Additionally, it is not proper use of a patent as a reference to modify its structure to one which prior art references do not suggest. *In re Randol and Redford*, 425 F.2d 1268, 165 U.S.P.Q. 586, 588 (C.C.P.A. 1970). A reference must be considered not just for what it expressly teaches, but also for what it fairly suggests to one who is unaware of the claimed invention. *In re Baird*, 16 F.3d 380, (Fed. Cir. 1994).

Furthermore, Bolea discloses a system for determining efficacy of a sterilization cycle. Bolea gives no mention of applying dry heat sterilization to radioactive seeds. The

Examiner merely attempts to pick and choose an unimportant item in Bolea, dry heat sterilization time, and use this single item as evidence of obviousness when viewed with Langton.

Accordingly, Applicants respectfully submit that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). (emphasis added).

Additionally, Langton in view of Bolea teaches away from the present invention. Teaching away' simply means teaching a solution that would not lead to the claimed subject matter. As noted by the Federal Circuit:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.
***Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085 (Fed. Cir. 1995).**

In the *Para-Ordnance* decision, the Federal Circuit clearly states that the prior art need only teach other, divergent, solutions to be deemed to teach away from an invention.

Thus, by teaching positively towards certain embodiments or features as being important or preferred, the art provides a motivation for the person skilled in the art to go in a

particular direction. If that direction leads towards subject matter outside the scope of the claims at issue, then it constitutes a "teaching away". Applicants maintain that the person skilled in the art, even if assumed to be contemplating improvements of Langton in view of Bolea, would not focus on sterlizing a seed train for more than one-hour. As stated by the Examiner in the Office Action, Langton does not disclose, teach, or suggest using a time of at least two hours for sterilization. One skilled in the art would be discouraged from increasing the one-hour time for sterilization in Langton because the seed train is sterilized and stiffened in one hour. Therefore, it would not be practical if one skilled in the art were to continue to apply dry heat at 180°C as disclosed in Bolea to the seed train in Langton if the seed train in Langton was already sterilized in one hour.

Furthermore, Applicants respectfully disclose that claims 3-5, 7-10, 12-13, 15 and 18-19 are dependent upon an independent claim or introduce further limitations of another dependent claim that is dependent on claim 1. In other words, dependent claims 3-5, 7-10, 12-13, 15 and 18-19 will stand or fall based on independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a) for claims 3-5, 7-10, 12-13, 15 and 18-19. It is, however, important to respectfully point out to the Examiner that the seeds of Langton are out of the ordinary and thus are isotropic. As indicated on column 2, lines 47-66, Langton reveals a dose distribution that is out of the ordinary.

Accordingly, Applicants respectfully request that the Examiner withdrawal the rejections for dependent claims 3-5, 7-10, 12-13, 15 and 18-19 under 35 U.S.C. §103(a) and direct that claims 3-5, 7-10, 12-13, 15 and 18-19 be allowed.

Nonstatutory Obviousness-type Double Patenting Rejection

Claims 1, 3-5, 7-10, 12-13, 15 and 18-19 stand rejected under 35 U.S.C. §103(a) on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-5 of United States Patent No. 6,692,426 to Faulkner ("Faulkner") in view of Langton and Bolea. Faulkner is the parent patent of the present invention. Both Faulkner and the present invention are owned by GE Healthcare, Limited.

In order to expedite prosecution, Applicants are filing herein the attached terminal disclaimer under 37 CFR 1.130 and 37 CFR 1.321.

CONCLUSION

Upon entry of this Amendment, claims 1, 3-5, 7-10, 12-13, 15, and 18-19 remain pending. Applicants submit that all outstanding issues have been addressed, and that claims 1, 3-5, 7-10, 12-13,15, and 18-19 are in condition for allowance, which action is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees under 37 CFR §1.16(j) or 37 CFR 1.136(a) which may be required, or credit any overpayment, to Deposit Account No. 502-665 in the name of GE Healthcare, Inc.

Should any other matters require attention prior to allowance of the application, it is requested that the Examiner contact the undersigned.

Respectfully submitted,

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